

Serial No.: 09/602,812

REMARKS

Claims 1, 2, 4, 7, 8, 12, 13, 16 and 20 are rejected under 35 USC §102(e) as being anticipated by Greene *et al.* as evidenced by Brabender *et al.* and also Zhang *et al.* Claims 1 and 24-26 are rejected under 35 USC Section 103(a) as being unpatentable over Greene *et al.* as evidenced by Brabender *et al.* and also Zhang *et al.* Claims 1, 2, 4, 7, 16, 20 and 22 are rejected under 35 USC Section 102(e) as being anticipated by Hudziak *et al.* as evidenced by Suzuki *et al.* and Shackney *et al.* Claims 1, 2, 7, 9, 16, 20, 34, and 60 are rejected under 35 USC Section 103(a) as being unpatentable over Hudziak *et al.* and Maurer *et al.*, Suzuki *et al.*, Shackney *et al.* or Bast *et al.*, in view of Klapper *et al.* Claims 1, 18, 19 and 21 are rejected under 35 USC Section 103(a) as being unpatentable over Hudziak *et al.* and Maurer *et al.*, Suzuki *et al.*, Shackney *et al.* or Bast *et al.*, in view of Klapper *et al.* as applied to claim 1, and further in view of Grim *et al.*

The Examiner bases the prior art rejections of claim 1 and its dependent claims on an interpretation of "cross-blocks binding" therein which includes 4D5 as such a cross-blocking antibody. In order to obviate the rejection, the Examiner suggested in the interview that the language "blocks by 50% or greater" be used in claim 1. Applicants have followed the Examiner's recommendation. Support for the recitation in claim 1 can be found on at least page 50, lines 26-27 of the specification. In that the 4D5 antibody does not block 2C4's binding by 50% or greater, the rejections of claim 1 and its dependent claims are mooted. As to the Section 103 rejection of claims 24-26, while Applicants respectfully disagree that the dosages and dosage schedules in those dependent claims are obvious over the art applied thereagainst, the rejection is mooted by the amendment of claim 1 upon which claims 24-26 depend. With respect to claim 34, the Examiner indicated in the interview that recitation of "colon, rectal and colorectal cancer which express but do not overexpress ErbB2" would negate the rejection of that claim. This amendment has been adopted herein and is believed to obviate the rejection of claim 34. As to claim 60, while Applicants believe that this claim is patentable over the art for at least the reason that Klapper *et al.* do not describe ErbB2 antibodies that block TGF- α activation of MAPK more effectively than Herceptin®, let alone use of such antibodies in the claimed method, the rejection is rendered moot by the nonprejudicial cancellation of claim 60. The amendment is made simply to accelerate allowance; Applicants specifically

Serial No.: 09/602,812

preserve the ability to pursue the cancelled claim in a continuing application. Reconsideration and withdrawal of the various 102 and 103 rejections is requested in view of the above.

Claims 61 and 63 are rejected under 35 USC §112, first paragraph. Without acquiescing in the rejection, and in order to expedite allowance, claims 61 and 63 are cancelled herein without prejudice or disclaimer. Applicants specifically preserve the ability to pursue the cancelled claims in a continuing application. Reconsideration and withdrawal of the §112, first paragraph rejection is requested.

Claims 17 and 62 are objected to as appearing to be claims of identical scope, and claim 17 is objected to for depending on a rejected claim. These objections are obviated by the nonprejudicial cancellation of claim 17 herein. Reconsideration and withdrawal of the objections is respectfully requested.

Claims 27, 34 and 60 are rejected under 35 USC §112, second paragraph as allegedly being indefinite because of the word "substantially." Applicants have followed the Examiner's suggestion and deleted the word "substantially" from pending claims 27 and 34, thus obviating this rejection. The rejection of claim 60 is rendered moot by its nonprejudicial cancellation as noted above. Reconsideration and withdrawal of the §112, second paragraph rejection is respectfully requested.

Claims 1, 2, 4-8, 16-22, 24-27 and 60-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 22-31 of copending Application No. 09/602,800. Applicants traverse the rejection for the reasons elaborated on page 13 of the amendment dated June 2, 2004. In any event, Applicants note that, according to MPEP 822.01, if the provisional double patenting rejection is the only remaining rejection in the case following entry of this amendment, the Examiner should withdraw the rejection and permit the above application to issue as a patent.

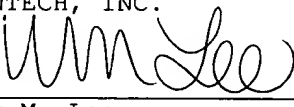
Applicants note that a Supplemental IDS was filed on January 27, 2004 citing ref. nos. 306-309. Applicants respectfully request that the initialed 1449 form be returned indicating the Examiner's consideration of same.

Serial No.: 09/602,812

Applicants look forward to early receipt of the notice of allowance. If there are outstanding issues following entry of this amendment, the Examiner is cordially invited to call the undersigned at the number noted below.

Respectfully submitted,
GENENTECH, INC.

Date: October 21, 2004

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